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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,798	03/06/2002	Amanda S. Schilling	83202	6616
23501	7590	08/17/2005	EXAMINER	
NAVAL SURFACE WARFARE CENTER, DAHLGREN DIVISION OFFICE OF COUNSEL, CODE XDC1 17320 DAHLGREN ROAD DAHLGREN, VA 22448-5110			SRIVASTAVA, KAILASH C	
		ART UNIT	PAPER NUMBER	
		1655		

DATE MAILED: 08/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/090,798	SCHILLING ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Dr. Kailash C. Srivastava	1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 23 May 2005.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,4,5,7,10-16 and 23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,4,5,7,10-16 and 23 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____.   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>05.06.2002</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## DETAILED ACTION

1. The Art Unit Location to which your application has been assigned at the USPTO is changed to Art Unit 1655. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Examiner Kailash C. Srivastava in Art Unit 1655.
2. A review of the papers in application file showed an Unconsidered Information Disclosure Statement (IDS) submitted 06 May 2002. Despite a mention from the applicants that all the documents listed on USPTO Form 1449 accompanying said IDS, none of the reference documents are present in the file. Applicant to note that at the time of filing of said IDS, applicants were required to submit every reference listed on said USPTO Form 1449. In the absence of said references, said IDS was placed in the Application file. Examiner inadvertently did not consider said IDS.

Said IDS has been made of record and partially considered to the extent that the U. S. Patent documents listed on said USPTO Form 1449 are available at the USPTO for the Examiner to consider. Duly signed USPTO Form 1449 indicating that the Examiner has considered the U.S. Patent Documents listed on said USPTO Form 1449  
is enclosed herewith. In response to this Office Action, Applicants are requested to furnish copies of Non-Patent Literature references on said USPTO Form 1449 for Examiner's consideration.

3. Applicant's response and amendment filed 23 May 2005 to Office Action mailed 03 March 2005 is acknowledged and entered. The text of those sections of Title 35 U.S. Code not included in this action can be found in a prior Office action.
4. Applicant's Declaration filed under 37 C.F.R §1.131 on 23 May 2005 is acknowledged and entered.

## CLAIMS STATUS

5. Claims 2-3, 6, 8-9, and 17-22 stand cancelled.
6. Claims 1 and 10 have been amended.
7. Claims 1, 4-5, 7, 10-16 and 23 are pending and are examined on Merits.

### ***Claim Rejections Under 35 U.S.C. § 112, second paragraph***

8. In view of applicants' amendments and arguments filed on 23 May 2005, Examiner hereby withdraws rejection under 35 U.S.C. §112, second paragraph to Claims 1, 4-5, 7, 10-16 and 23 in Office Action mailed 03 March 2005.

### ***Claim Rejections Under 35 U.S.C. § 102***

9. In view of applicants' amendments, arguments and Declaration under 37 C.F.R §1.131 filed on 23 May 2005, Examiner hereby withdraws anticipatory rejection under 35 U.S.C. §102 (e) to Claims 1, 4-5, 7, 10-13, 16 and 23 as anticipated by Baugh et al. (U.S. Patent 6,656,919 B1) in Office Action mailed 03 March 2005.

### ***Claim Rejections Under 35 U.S.C. § 103(a)***

10. In view of applicants' amendments, arguments and Declaration under 37 C.F.R §1.131 filed on 23 May 2005, Examiner hereby withdraws rejections to Claims 1, 4-5, 7, 10-16 and 23 under 35 U.S.C. §103 (a) as obvious over Baugh et al. (U.S. Patent 6,656,919) in view of Paidhungat et al. (Journal of Bacteriology, 2000, Volume 182, Pages 2513-2519) and Baker et al (U. S. Patent 6,506, 803) for the reasons of record in the Office Actions mailed 05 March 2004 (Please see items 9-10), 17 August 2004 (Please see item 10) and of 03 March 2005 (Please see item 10).

11. Claims 1, 4-5, 7, 10-16 and 23 remain rejected under 35 U.S.C. § 103 (a) as obvious over Clouston (U.S. Patent 3,617,178) in view of Paidhungat et al. (Journal of Bacteriology.2000, Volume 182, Pages 2513-2519) and Baker et al (U. S. Patent 6,506, 803) for the reasons of record in the Office Actions mailed 05 March 2004 (Please see items 9-10), 17 August 2004 (Please see item 10) and of 03 March 2005 (Please see item 10).

In response to the art rejections in Office Actions cited *supra*, applicants argue that the claimed invention is unobvious over the cited references and "the Examiner has failed to provide a *prima facie* case to deny patentability of the present invention". Applicants argue that their statement cited *supra* is because of the fact that the Examiner-cited references do not disclose or suggest, or provide motivation to arrive at the presently claimed invention. Excerpting Examiner's previous rejections, applicants further argue that "The Examiner's proposition that intrinsically, Clouston teaches the general principle of first or simultaneous germinating and killing of bacterial spores to sterilize/ decontaminate a liquid/solid contaminated with bacterial spores" because of Clouston's teachings cited in said reference seems erroneous in the context of instantly claimed invention because the instantly claimed invention does not disclose pressure as a means of germinating bacterial spores and the teachings from Examiner-cited secondary references (i.e., Paidhungat et al. and Baker et al) do not remedy the deficiency cited above in Clouston's teachings.

In response to applicants' argument that there is no motivation to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of

ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, those reasons are cited at items 9-10 in Office Action mailed 05 March 2004 and item 10 of the Office actions mailed 17 August 2004 and on 03 March 2005 respectively and further because *an undisclosed advantage (i.e., pressure as in Clouston's teachings) is given little or no patentability weight*. Furthermore, a rejection under 35 U.S.C. § 103 (a) based upon the combination of references is not deficient solely because the references are combined based upon a reason or technical consideration which is different from that which resulted in the claimed invention (*Ex parte Raychem Corp.*, 17 U.S.P.Q. 2d 1417).

In response to applicant's arguments against the references individually, one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

## CONCLUSION

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. For the aforementioned reasons, no claims are allowed.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Kailash C. Srivastava whose telephone number is (571) 272-0923. The examiner can normally be reached on Monday to Thursday from 7:30 A.M. to 6:00 P.M. (Eastern Standard or Daylight Savings Time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Bruce Campbell, can be reached on (571)-272-0974 Monday through Friday 8:00 A.M. to 4:30 P.M. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding may be obtained from the Patent Application Information Retrieval (i.e., PAIR) system. Status information for the published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (i.e., EBC) at: (866)-217-9197 (toll-free). Alternatively, status inquiries should be directed to the receptionist whose telephone number is (703) 308-0196.

~~K~~ailash C. Srivastava, Ph.D.  
Patent Examiner  
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August 11, 2005

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